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JUL 20 2009

OFFICE OF PETITIONS

In re Application of :
Carter et al. : ON APPLICATION FOR
Application No. 10/528,250 : PATENT TERM ADJUSTMENT
Filed: June 21, 2005 :
Attorney Docket No. NVV2- :
023USRCE :

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT RECONSIDERATION UNDER 37 C.F.R. § 1.705(B) filed June 2, 2009. Applicants submit that the correct patent term adjustment to be indicated on the patent is three hundred seventy (370) days, not two hundred thirty-eight (238) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction solely on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Charlema Grant at (571) 272-3215.

Kery A Fries

Kery Fries.
Senior Legal Advisor Attorney
Office of Patent Legal Administration

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the office electronic filing system in accordance with § 1.6(a)(4), on the date shown below.

Dated: June 2, 2009

Electronic Signature for Elizabeth A. Hanley: /Elizabeth A. Hanley/

Docket No.: 117750-02301
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Malcolm Carter *et al.*

Application No.: 10/528,250

Confirmation No.: 2767

Filed: June 21, 2005

Art Unit: 1624

For: BENZODIAZEPINE DERIVATIVES AND
PHARMACEUTICAL COMPOSITIONS
CONTAINING THEM

Examiner: Bruck KIFLE

MS Patent Extension
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR
RECONSIDERATION UNDER 37 C.F.R. § 1.705(b)**

Dear Sirs:

1. This is an application for Patent Term Adjustment, pursuant to 35 USC § 154(b), to correct the Patent Term Adjustment indicated on the Notice of Allowance mailed on April 22, 2009. It is respectfully requested that Applicants be granted a minimum Patent Term Adjustment of 370 days.

2. The issue fee for the present patent application will be paid on June 2, 2009 which is no sooner than the filing date of this application for Patent Term Adjustment. Accordingly, the instant application for Patent Term Adjustment is timely filed pursuant to 37 C.F.R. § 1.705(b). Applicants also submit herewith:

- the fee set forth in 37 C.F.R. § 1.18(e), and
- a "Statement Under 37 C.F.R. § 1.705(b)(2)" which specifies

the correct Patent Term Adjustment and the bases under 37 C.F.R. § 1.702 for the adjustment; the relevant dates under 37 C.F.R. §§ 1.703(a)-(e) for which adjustment is sought; the adjustment specified in 37 C.F.R. § 1.703(f) to which the patent is entitled; and whether the patent is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer.

3. Applicants respectfully request grant of this Application for Patent Term Adjustment.
4. In accordance with 37 C.F.R. 1.705(b)(2)(i), Applicants submit herewith the fee set forth in 37 C.F.R. 1.18(e). It is Applicants' understanding that this \$200.00 fee is required for this application for Patent Term Adjustment. However, should any additional fees be necessary, the Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-4876, under Order No. 117750-02301..

Dated: June 2, 2009

Respectfully submitted,

By Elizabeth A. Hanley/
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